

REMARKS

Claims 1, 4, 5, 7-11, 14, 15, 20-27, and 29 are pending, with claims 1 and 30 being independent. Claim 30 has been amended to rewrite previously dependent claim 30 in independent form and claim 28 has been canceled without prejudice to or disclaimer of subject matter recited therein. Applicants expressly reserve the right to file one or more continuation applications directed to the subject matter of canceled claim 28. Reconsideration and allowance in view of the above amendments and following remarks are respectfully requested.

Claim Rejections – 35 U.S.C. § 103

- I -

Claim 28 stands rejected under 35 U.S.C. §103(a) as allegedly unpatentable over U.S. Patent No. 6,777,152 in view of the *Handbook of Imaging Materials*, 2nd Edition, by Diamond, pages 202-203 ("Diamond") and further in view of U.S. Patent No. 6,096,468 ("Ohno"). The rejection is respectfully traversed.

Applicants respectfully submit that the cancellation of Claim 28 renders this rejection moot.

- II -

Claims 1, 4, 5, 7-11, 14, 15, 20-27, and 30 stand rejected under 35 U.S.C. §103(a) as allegedly unpatentable over U.S. Patent No. 6,130,020 ("Wada") in view of Diamond and further in view of Ohno. The rejection is respectfully traversed.

Claims 1, 4, 5, 7-11, 14, 15, 20-27, and 30

The present invention provides an electrostatic-latent-image developing toner that is superior in charging stability against continuous use and environmental

fluctuations, and capable of providing an image virtually free from fogging and degradation in the image density for a long time, as well as a full-color image-forming method using such a toner.

Independent claim 1 recites a toner comprising toner particles that are manufactured by a wet granulating method and contain a binder resin and a colorant and an external additive comprising hydrophobic inorganic fine particles selected from the group consisting of silica, titanium oxide, alumina, zinc oxide, and mixtures thereof and composite oxide fine particles having a specific surface area of not more than $300 \text{ m}^2/\text{g}$, each of the composite oxide fine particles contain a Si atom and at least one atom of a metal selected from the group consisting of Ti, Zr, Fe, Nb, V, W, Sn and Ge. The toner particles have an average degree of roundness of not less than 0.950.

Amended independent claim 30 recites a toner for forming a full color image comprising: toner particles that are manufactured by a wet granulating method and contain a binder resin and a colorant; and composite oxide fine particles having a specific surface area of not more than $300 \text{ m}^2/\text{g}$. Each of the composite oxide fine particles contains at least two metal atoms selected from metals of the group consisting of Si, Ti, Zr, Fe, Nb, V, W, Sn and Ge. The composite oxide fine particles are externally added to the toner particles, and the toner particles have an average degree of roundness of not less than 0.950. Hydrophobic inorganic fine particles selected from the group consisting of silica, titanium oxide, alumina, zinc oxide, and mixtures thereof are also added externally to the toner particles.

Wada discloses a developing agent comprising: (1) toner particles containing at least a binder resin and a coloring agent; and (2) metallic oxide fine particles represented by a composition formula $\text{Si}_x\text{A}_y\text{O}_{(4x+yZ)/2}$ (wherein the character A

represents a metallic element, the character Z represents a valence number of element A, and x/y is 1-25), the metallic oxide fine particles being hydrophobically treated if desired.

Diamond is cited as teaching "that a latex aggregation toner formation (i.e., wet granulation . . .) method has become increasingly desirable". (Office Action, Page 5).

Ohno is cited as teaching "that toners having a roundness (i.e., circularity) of 0.950 to 0.995, more preferably 0.970 to 0.990 having improved transfer performance and are useful in development of low potential latent images". (Office Action, Page 5).

The Examiner asserts, "It would have been obvious to one having ordinary skill in the art at the time the invention was made to produce the toner of Wada by a granulation (i.e., aggregation) method because this method permits the artisan to obtain small toner particles with a narrow particle size, which is desirable as taught by Diamond." (Office Action, Page 5).

It is respectfully submitted that one having ordinary skill in the art at the time the invention was made would not have attempted to produce the toner of Wada by a wet granulation method. In particular, Wada discloses that a "kneading/grinding method is preferably employed [to produce toner particles] from the standpoints of production cost and production stability." (Column 4, Lines 66-67). Further, in the Examples of Wada only a kneading/grinding method is used. Therefore, while it can be said that Wada teaches a kneading/grinding method, Wada neither teaches nor suggests a wet granulating method. In fact, the Examiner acknowledges that Wada "does not specify a wet granulation method for formation of the toner particles".

(Office Action, Page 5). In addition, Wada neither discloses nor suggests the problem of the present invention (*i.e.*, stability with respect to environmental fluctuations). Diamond also does not describe the problem of the present invention.

In addition to neither Wada nor Diamond disclosing the problem of the present invention, Wada does not disclose any deficiencies or difficulties with the developing agent described therein. Accordingly, Applicants respectfully submit that there would be no suggestion or motivation to modify Wada or combine Wada with Diamond (and Ohno). As explained in MPEP § 2143.01, the mere fact that references can be combined or modified does not render the resultant combination obvious. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990).

Claims 4, 5, 7-11, 14, 15 and 20-27 recite additional features of the invention and are allowable for the same reasons discussed above with respect to claim 1 and for the additional features recited therein.

Reconsideration and withdrawal of the rejection of claims 1, 4, 5, 7-11, 14, 15 and 20-27 over Wada in view of Diamond and further in view of Ohno is respectfully requested.

- III -

Claim 29 stand rejected under 35 U.S.C. §103(a) as allegedly unpatentable over Wada in view of the Diamond and further in view of Ohno, and further in view of U.S. Patent No. 6,967,070 ("Nakamura"). The rejection is respectfully traversed.

Nakamura, cited as allegedly disclosing "a wax that is usefully included in a toner" (Official Action, Page 6, does not cure the above-noted deficiencies of Wada, Diamond, and Ohno.

Accordingly, withdrawal of this ground of rejection is respectfully requested.

Conclusion

In view of the above amendments and remarks, it is respectfully submitted that all of the claims are allowable and the entire application is in condition for allowance.

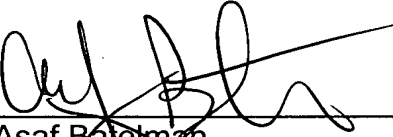
Should the Examiner believe that anything further is necessary to place the application in condition for allowance, the Examiner is invited to contact the undersigned at the telephone number listed below.

Respectfully submitted,

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